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EXAMINER				
WINTER, JOHN M				
ART UNIT		PAPER NUMBER		
3685				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary

Application No.

09/500,601

Applicant(s)

SANCHO, ENRIQUE DAVID

Examiner

JOHN M. WINTER

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/19/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. The Applicants amendment filed on August 3, 2009 is hereby acknowledged, Claims 16-39 remain pending .

Response to Arguments

2. The Applicant states that a "generating" operation is not needed , as the claim language is unambiguous. One of ordinary skill in the art would understand claim 16, as it is written. The Examiner responds that without a generation step, it is unclear how the identification is obtained.

The Applicant states that Archibald does not teach or suggest claim 16's operation for receiving a fingerprint file.

The Examiner responds that the claimed feature of "said first computer fingerprint file including at least one identifying characteristic associated with at least one hardware component of the user computer" does not restrict the "characteristic" to being a hardware identifier, since what is claimed is merely an "association" with the hardware. For example a data stamp generated by hardware would be sufficient to meet the claimed limitation. In the present rejection Archibald et al. ('883) discloses a meter identification file that is "associated" with a specific meter via a meter identification code. (column 6, line 40), Archibald discloses receiving a data file (i.e. "fingerprint file) comprising a user ID and a meter ID where the meter ID is based upon a characteristic of the meter. The Examiner submits that these feature meet the limitations of the presently claimed invention.

The Applicant states that Klein does not teach or suggest claim 16's receiving and comparing of fingerprint files.

The Examiner states that this feature is disclosed by Padgett. See following rejection. – Examiner notes that “upon comparing” is directed toward a conditional step. Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] ” As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 states “a first identification for the user generated using the first computer fingerprint file” however there is no corresponding step of generation, it is therefore unclear how the identification is obtained.

Claims 17-39 are either dependant upon claim 16 or contain similar limitations and are rejected for at least the same reason.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 16-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padgett et al (US Patent 6,167,518) in view of Archibald et al. (US Patent 5,825,883).

4. As per claims 16 and 34,

Padgett et al (*518) discloses a computer-implemented method for facilitating an electronic commerce transaction by remotely verifying a user and a user computer involved in the electronic commerce transaction, the method comprising:

receiving, in a verification computer, a request for verification from a user computer; in response to the request for verification, sending at least one request to the user computer;

(Figure 1)

comparing the first identification for the user against a second identification for the user to verify the user, the second identification for the user accessible by the verification computer;(Column 2, lines 61-67; column 3 lines 1-6)

Padgett et al. ('518) does not explicitly disclose receiving at least one response from the user computer, the at least one response including a first computer fingerprint file and a first identification for the user generated using the first computer fingerprint file, said first computer fingerprint file including at least one identifying characteristic associated with at least one hardware component of the user computer; Archibald et al. ('883) discloses receiving at least one response from the user computer, the at least one response including a first computer fingerprint file and a first identification for the user generated using the first computer fingerprint file, said first computer fingerprint file including at least one identifying characteristic associated with at least one hardware component of the user computer; (figure 2 and 16, at column 6, line 36 states use of "meter identification code"). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Padgett et al.'s teachings with the Archibald et al. ('883) method in order to prevent unauthorized usage of a computer system.

Padgett et al. ('518) discloses comparing the first computer fingerprint file, which includes at least one identifying characteristic associated with at least one hardware component of the user computer, against a second computer fingerprint file, to verify the user computer, the second computer fingerprint file accessible by the verification computer, said second computer fingerprint file including at least one identifying characteristic associated with at least one hardware component of the a-user computer; sending at least one verification response to the user computer, based upon the comparing of the first computer fingerprint file against the second computer fingerprint file and upon the comparing of the first identification for the user against the second identification for the user. Column 7, line 46 –

column 8 line 38 – Examiner notes that “upon comparing” is directed toward a conditional step. Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] ” As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.).

5. As per claim 17,

Padgett et al ('518) discloses the method according to claim 16

Padgett et al ('518) does not explicitly disclose the verification computer is a clearinghouse computer. Archibald ('883) discloses the verification computer is a clearinghouse computer.(Figure 1, column 3, lines 57-67) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Padgett et al ('518) method with the Archibald ('883) method in order to increase security in systems that utilize fingerprint comparisons without requiring additional hardware costs.

6. As per claim 18,

Padgett et al ('518) discloses the method according to claim 16

Padgett et al ('518) does not explicitly disclose the verification computer is a vendor computer. Archibald ('883)discloses the verification computer is a vendor computer.(Figure 1, column 3, lines 57-67) It would have been obvious to one having ordinary skill in

the art at the time the invention was made to combine the Padgett et al (*518) method with the Archibald (*883) method in order to increase security in systems that utilize fingerprint comparisons without requiring additional hardware costs.

7. As per claim 19,

Padgett et al (*518) discloses A method according to claim 16, wherein said step of sending at least one request to a user computer includes:

sending a first request to the user computer for the first computer fingerprint file; and

sending a second request to the user computer for the first identification for the

user.(Column 5, lines 16-26, Figure 2)

8. As per claim 20,

Padgett et al (*518) discloses a method according to claim 16, wherein said step of receiving at least one response from the user computer includes:

receiving a first response from the user computer including the computer fingerprint file;

and receiving a second response from the user computer including the first identification for the user.(Column 5, lines 43-44)

9. As per claim 21,

Padgett et al (*518) discloses a method according to claim 16,

Official Notice is taken that “the second response from the user computer is received prior to first response from the user computer” is common and well known in prior art in

reference to network communications. It would have been obvious to one having ordinary skill in the art at the time the invention was made that replies from a client might be received out of order because of the nonhomogenous nature of computer networks, i.e. The first response could be delayed due a large amount of network traffic while the second response might be routed differently and be received prior to the first transmission. The Examiner noted that this feature is common to Email systems such as SMTP.

10. As per claim 22,

Padgett et al ('518) discloses a method according to claim 16,

Official Notice is taken that “steps of comparing the first computer fingerprint file against a second computer fingerprint file, and comparing the first identification for the user against a second identification for the user are not performed simultaneously” is common and well known in prior art in reference to authentication via database. It would have been obvious to one having ordinary skill in the art at the time the invention was made that comparison of identification feature would not occur simultaneously in order to provide more efficient processing of the data, by comparing the fingerprint files sequentially processing time is save if the first comparison fails, rendering the second comparison unnecessary

11. As per claims 23 and 37,

Padgett et al ('518) discloses a method according to claim 18, wherein said step of sending at least one response to the vendor computer, based upon the comparing of the first computer fingerprint file against the second computer fingerprint file and upon the

comparing of the first identification for the user against the second identification for the user includes

sending a confirmation only when both the first fingerprint file and the first identification of the user match the second fingerprint file and the second identification for the user respectively.(Column 6, lines 40-49)

12. As per claim 24,

Padgett et al ('518) discloses a method according to claim 19, wherein said step of receiving at least one response from the user computer includes:

receiving a first response from the user computer including the first fingerprint file; and receiving a second response from the user computer including the first identification for the user.(Figure 2)

13. As per claim 25,

Padgett et al ('518) discloses a method according to claim 24,

Official Notice is taken that “the second response from the user computer is received prior to first response from the user computer” is common and well known in prior art in reference to network communications. It would have been obvious to one having ordinary skill in the art at the time the invention was made that replies from a client might be received out of order because of the non- homogenous nature of computer networks, ie. The first response could be delayed due the a large amount of network traffic while the second

response might be routed differently and be received prior to the first transmission. The Examiner noted that this feature is common to Email systems such as SMTP.

14. As per claims 26 and 38,

Padgett et al ('518) discloses a method according to claim 16,

(a) wherein the first identification for the user includes a password.(Column 5, lines 13-22)

15. As per claims 27, 28 and 39,

Padgett et al ('518) discloses a method according to claim 16,

Official Notice is taken that “the first computer fingerprint file includes information based upon an identification number of a CPU [or MAC address]of the user computer” is common and well known in prior art in reference to authentication. It would have been obvious to one having ordinary skill in the art at the time the invention was made that a hardware identifier such as a CPU ID or MAC address would be included along with a users identity in order to increase the security of the system by preventing access from unauthorized locations.

16. As per claims 29 and 35-36,

Padgett et al ('518) discloses a method according to claim 16, wherein prior to the step of receiving the first request from the verification computer,

storing the second fingerprint file in a first data base accessible by verification computer, and storing the second identifications for the user in a second database accessible by the verification computer. (Figure 3)

17. As per claim 30,

Padgett et al ('518) discloses a method according to claim 16, wherein prior to the step of receiving the first request from the vendor computer, storing the second fingerprint file in a first data base accessible by a clearinghouse computer, and storing the second identifications for the user in a second database accessible by a clearinghouse computer. (Figure 3)

18. As per claim 31,

Padgett et al ('518) discloses the method according to claim 30

Official Notice is taken that "first database and second database are the same" is common and well known in prior art in reference to authentication. It would have been obvious to one having ordinary skill in the art at the time the invention was to not use multiple databases in order to increase the performance of the system by reducing the number of database transactions made

19. As per claim 32,

Padgett et al ('518) discloses the method according to claim 18 wherein the step of receiving a request from a vendor computer includes

receiving an Internet address of the user computer.(Figure 3)

20. As per claim 33,

Padgett et al ('518) discloses the method according to claim 32

Official Notice is taken that “identifying the user computer based upon the Internet address received from the vendor computer” is common and well known in prior art in reference to authentication. It would have been obvious to one having ordinary skill in the art at the time the invention was made that a identifier such as an Internet address would identify the user in order to increase the security of the system by preventing access by unauthorized people.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

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